

SOLICITOR

AO 120 (Rev. 2/99)

AUG 11 2008

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 08-03726 EMC	DATE FILED 8/4/08	U.S. DISTRICT COURT 450 Golden Gate Avenue, P.O. Box 36060, San Francisco, CA 94102
PLAINTIFF ADVANCED SEMICONDUCTOR ENGINEERING, ET AL.		DEFENDANT TESSERA, INC.

PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 see Complaint		
2 5,663,106		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK <div style="text-align: center;">Richard W. Wicking</div>	(BY) DEPUTY CLERK <div style="text-align: center;">Sheila Rash</div>	DATE <div style="text-align: center;">August 5, 2008</div>
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

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RICHARD W. WIEKING
CLERK
U.S. DISTRICT COURT
NO. DIST. OF CA S.J.

E-FILED

6 Attorneys for Plaintiffs
7 ADVANCED SEMICONDUCTOR ENGINEERING, INC., ASE TEST LIMITED, and ASE
(U.S.), INC.

ADR
UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

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9
10 ADVANCED SEMICONDUCTOR ENGINEERING, INC., ASE TEST LIMITED, and ASE (U.S.) INC,

Case No.:

008 03726

11 Plaintiffs,

12 vs.

13 TESSERA, INC.,

14 Defendants.

COMPLAINT FOR
DECLARATORY JUDGMENT
OF NON-INFRINGEMENT AND
INVALIDITY OF U.S. PATENT
NO. 5,663,106

EMC

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1 8. Personal jurisdiction and venue over Tessera are proper in this District as
2 Tessera markets and licenses its patent portfolio within this jurisdiction and has conceded
3 jurisdiction in concurrent litigation pending before Judge Wilken.

4 **FACTUAL BACKGROUND**

5 9. On September 2, 1997, the United States Patent Office issued the '106
6 Patent, entitled "Method of Encapsulating Die and Chip Carrier." The '106 Patent states on its
7 face that Tessera is its assignee. Exhibit A, page 1.

8 10. On August 1, 2008, Tessera informed ASE that Tessera intended to move to
9 add the '106 Patent to the pending International Trade Commission Investigation entitled *In the*
10 *Matter of Certain Semiconductor Chips with Minimized Chip Package Size and Products*
11 *Containing Same (IV)*, ITC Inv. No. 337-TA-649 ("the 649 Investigation"), alleging that ASE is
12 infringing the '106 Patent.

13 11. At present, the parties are involved in two separate cases: the 649
14 Investigation and a pending patent infringement case in United States District Court in the
15 Northern District of California, Case No. 05-4063 CW, before the Honorable Claudia Wilken.
16 Each case has multiple Patents in Suit and concern products similar to those products which
17 Tessera contends infringe the '106 Patent.

18 12. By reason of the foregoing, there is a justiciable controversy between ASE
19 and Tessera concerning non-infringement and invalidity of the '106 Patent.

20 13. ASE therefore seeks a Declaratory Judgment from this Court that ASE's
21 packaging services have not and do not infringe Tessera's '106 Patent, either directly, indirectly,
22 or otherwise.

23 14. ASE also seeks a Declaratory Judgment from this Court that Tessera's '106
24 Patent is invalid.

25 **FIRST CLAIM FOR RELIEF**

26 15. Plaintiff ASE realleges and repeats the allegations of paragraphs 1-14 as
27 through fully set forth herein.
28

1 16. ASE seeks a Declaratory Judgment from this Court, under Fed. R. Civ. P.
2 57 and 28 U.S.C. §§ 2201 and 2202, declaring the '106 Patent to be not infringed by ASE, and
3 granting ASE all other declaratory relief to which it may be entitled.

4 **SECOND CLAIM FOR RELIEF**

5 17. Plaintiff ASE realleges and repeats the allegations of paragraphs 1-16 as
6 through fully set forth herein.

7 18. ASE seeks a Declaratory Judgment from this Court, under Fed. R. Civ. P.
8 57 and 28 U.S.C. §§ 2201 and 2202, declaring that the claims of the '106 Patent are invalid for
9 failing to satisfy one or more requirements of the Patent Statute, including, without limitation, 35
10 U.S.C. Sections 101, 102, 103, 112, and 282.

11 **PRAYER FOR RELIEF**

12 WHEREFORE, ASE respectfully requests that the Court:

13 A. issue a Judicial Declaration that:

14 1. Advanced Semiconductor Engineering, Inc., ASE Test Limited, and
15 ASE (U.S.) Inc. have not infringed and are not infringing any claim of Tessera's United States
16 Patent No. 5,663,106, either directly, indirectly, or otherwise.

17 2. The claims of Tessera's United States Patent No. 5,663,106 are
18 invalid.

19 B. grant any and all equitable relief to which Advanced Semiconductor
20 Engineering, Inc., ASE Test Limited, and ASE (U.S.) Inc. are entitled;

21 C. award Advanced Semiconductor Engineering, Inc., ASE Test Limited, and
22 ASE (U.S.) Inc. all other and further relief to which they may be entitled; and

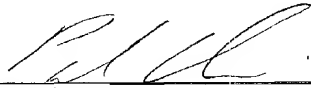
23 D. order such relief as the Court deems just and equitable.

24 **JURY DEMAND**

25 Advanced Semiconductor Engineering, Inc., ASE Test Limited, and ASE (U.S.)
26 Inc. demand a trial by jury of all issues triable of right by a jury.

1 Dated: August 4, 2008

2 THELEN REID BROWN RAYSMAN &
3 STEINER LLP

4 By 
5 Robert E. Camors, Jr.
6 Papool S. Chaudhari

7 Attorneys for Plaintiffs
8 Advanced Semiconductor Engineering, Inc., ASE
9 Test Limited, and ASE (U.S.), Inc.

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